**Remarks**

Claims 1 and 14 to 22 are pending in the application, and all were rejected. This application relates to an energy guide chain for a vehicle, and the guide chain has certain bending characteristics that are new and nonobvious. Applicants respectfully submit that the claims are not anticipated and would not have been obvious because there is no disclosure, teaching, motivation or suggestion of the claimed invention in the art of record. Nonetheless, amendments to the claims are made herein to clarify the claims and traverse the rejections. Applicant respectfully requests the withdrawal of the rejections and allowance of the claims.

**Amendments**

Claims 1 and 22 are amended herein to recite that the energy guide chain between the first and second ends bends in *only* one direction. The term "region" is deleted. Claims 1 and 22 are the only independent in the application, and all other claims depend from claim 1. Further, claims 1 and 22 now recite that the carrier moves with the sliding door "from the closed position to the open position" to address the interpretation put forth in the action at p. 6, suggesting that the carrier in *Murofushi et al.* "move a little."

Claims 19 and 20 are amended to delete the recitations to "region" for consistency with amended claim 1.

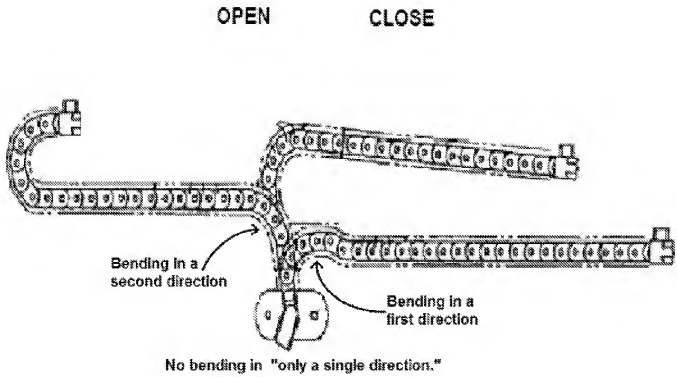
The combined effect of these amendments avoids any possible interpretation that the "region" is something less than the entire length of the energy guide chain between the first and second ends. Further, the chain now bends *only* in one direction to avoid a possible interpretation that the chain can bend in a single direction at one time and in another direction at another time, for example. Thus, the amendments do not limit the claims any more than was originally intended, but

the amendments are believed to address the examiner's explanation for the rejection at page 3 of the action.

**Bending in a Single Direction**

In particular, the amendments more clearly distinguish *Kobayashi et al.*'s disclosure of a chain that has a "second region" (as identified in the examiner's marked-up version of a drawing on page 3 of the action) that bends in two directions. The "second region" is illustrated as bending in two directions, but it appears the examiner may be asserting that the "second region" somehow excludes a bend in an opposite direction. The claims now make clear that the entire energy guide chain between the first end and the second end bends in *only* a single direction. Thus, for this additional reason, the drawing at page 3 of the action is distinguished.

The following is a marked up version *Kobayashi et al.* Fig. 3 to specifically show that the chain of *Kobayashi et al.* bends in a first direction and then in a second direction as the door moves. This is not a disclosure, teaching, motivation or suggestion of the claimed energy guide chain that "bends only in a single direction." Thus, the claims are not anticipated and they would not have been obvious to one of ordinary skill in the art.




Viewing the above figure, there is no doubt that the *Kobayashi et al.* chain bends in two directions. Applicant is unclear how the action can assert otherwise. If the examiner continues to reject the claims by alleging that *Kobayashi et al.* bends in only a single direction, then Applicant respectfully requests a more detailed explanation.

**Rejections**

**Anticipation Rejection**

Claim 22 was rejected under 35 U.S.C. 102(e) as being anticipated by *Kobayashi et al.* (US 2004/0003543). The examiner asserts, "*Kobayashi et al.* discloses an energy guide chain system for a vehicle, the vehicle having a chassis B and a sliding door SD that can be moved between a closed position and an open position on the chassis, and the energy guide chain system comprises: a carrier 30 connected to the sliding door; and an energy guide chain 1 having: a first end connected to the

carrier 30 for movement with the sliding door and a second end connected to the chassis at 21; and a region (not numbered, but shown in figure 3) between the first end and the second end and the region bends in a single direction, and the region has a first section that defines a first radius of curvature when the sliding door is in the open position, and a second section that defines a second radius of curvature when the sliding door is in the closed position." This remark suggests that the amendments made herein clarify the claims to eliminate an interpretation that the "region" is less than the entire chain length end-to-end, and to emphasize bending in *only* a single direction.

To maintain a rejection under 35 U.S.C. §102(b), all of the elements of each claim must be disclosed in a single reference. The test for anticipation requires a strict, not substantial, identity of corresponding claim elements. Finisar Corp. v. DirecTV Group, Inc., 523 F.3d 1323, 1334-35, 2008 U.S. Appl. LEXIS 8404, 27-28 (Fed. Cir. 2008). *Kobayashi et al.* fails to disclose bending in only a single direction and, thus, does not anticipate amended claim 22.

**Obviousness Rejections**

Claims 1, 14, 15 and 19 to 21 were rejected under 35 U.S.C. §103(a) as being obvious over *Murofushi et al.* (U.S. Patent 6492592) in view of *Suzuki* (U.S. Patent 6787702).

Claims 16 and 35 were rejected under 35 U.S.C. 103(a) as being obvious over *Murofushi et al.* in view of *Suzuki*.

The action asserts that *Murofushi et al.* item 39 of Fig. 2 is an energy guide 39. This "guide" is actually a coil spring that maintains a bent shape, but does not move with the sliding door (col. 6, lines 50 to 56, Figs. 1, 5, and 6, for example). The examiner acknowledges that the energy guide 39 is not a chain, but asserts that one skilled in the art would have known to replace the spring with an energy guide chain of *Suzuki* (action, p. 5). There is no citation to the art of record that such a change would have been known to one skilled in the art.

This is particularly true in view of the present claim amendments reciting that the guide chain bends in only a single direction. Springs have no ability to bend *only* in a single direction, so this further proves that one skilled in the art would not replace the spring with a chain. The amended claims herein would not have been obvious because *Murofushi et al.* fails to disclose and energy guide chain or spring that bends in only a single direction or the other recited features. Indeed, the whole point of a guide chain is to control bending in ways that cannot be done by a coil spring. *Suzuki* not only fails to disclose the interchangeability of springs and chains, it fails to disclose a chain that bends in only a single direction.

Indeed, if one skilled in the art were to combine the *spring* of *Murofushi et al.* and the chain of *Suzuki*, the only outcome taught by the references is that the chain would bend just as it does in *Suzuki*, since nothing in either patent explains how the coil spring would bend in *only* one direction as the sliding door moves. Thus, the legal standard for an obviousness rejection has not been met in this case because, for example, there is no indication in the art of record that one skilled in the art would reasonably expect success in combining *Murofushi et al.* and *Suzuki* to arrive at the claimed invention. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Further, as shown at Figs. 7 and 8 of *Murofushi et al.,* the coil spring (39) and the bent portion (38) do not follow the movement of the sliding door, and *Suzuki*'s chain does not bend in the manner recited in the claims. Thus, the claims would not have been obvious to one of ordinary skill in the art because there is nothing in the art of record (or the office action) suggesting, teaching, or motivating the claimed combination other than the examiner's opinion.

The examiner also asserts at page 6 of the action that the sliding block 4 of *Murofushi et al.* "has to move 'a little' when the door is moved into its fully opened position in order to pull the the bent portion rearward." The examiner's opinion is contrary to *Murofushi et al.*'s description of the

item as a "sliding block." Nonetheless, minor amendments to independent claims 1 and 22 address this interpretation by reciting that the first end is "directly connected to the carrier for movement with the sliding door from the closed position to the open position. .." Thus, *Murofushi et al.* does not disclose this feature even considering the examiner's comments at page 6 of the action.

Claims 1, 14, 15, and 19 to 21, are nonobvious and should be allowed.

Finally, claims 16 to 18 were rejected even though it is acknowledged that "*Murofushi et al.,* as modified above, is silent concerning specific radii of curvature." (Action, p. 5.) The reason *Murofushi et al.* is silent, whether "modified" or not, is that springs cannot control radii of bending, as recited in the claims. Such an inability to control bending proves that the art would not have taught, suggested or motivated one skilled in the art to arrive at the claimed invention. Thus, claims 16 to 18 are nonobvious for this additional reason and should be allowed.

**Conclusion**

For the foregoing reasons, Applicants respectfully submit that the claims are allowable and requests that this case be passed to issue.

Respectfully submitted,

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